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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,945	06/12/2006	Roger William Frank Ashton	10557/323979	1484
30559 7590 01/06/2009 CHIEF PATENT COUNSEL SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116				
EXAMINER COTRONEO, STEVEN J				
ART UNIT 4138		PAPER NUMBER		
MAIL DATE 01/06/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,945

Applicant(s)

ASHTON ET AL.

Examiner

STEVEN J. COTRONEO

Art Unit

4138

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16, 18-22, 24, 25, 27, 28 and 31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5-16, 18-22, 24, 25, 27, 28 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/21/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is short and does not sufficiently disclose the invention. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the cylindrical boss" in line two of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

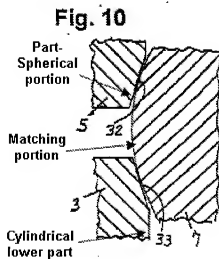
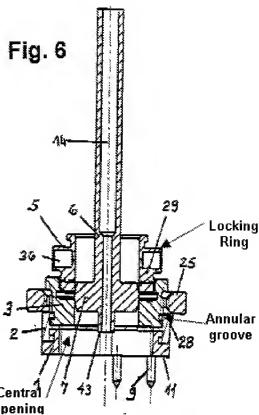
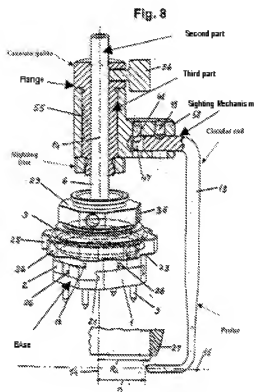
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-6, 11-15, 18-22, 27-28 and 31 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Publication 2002/0193801 to Marchione et al.

Marchione et al. discloses an apparatus comprising a base part for securement to a head of the femur (fig 6, #1, #2); a part securable to the base part and spherically adjustable relative thereto (fig 6, #7); a third part for directly or indirectly receiving a wire guide, and arranged for plan or adjustment, the wire guide receiving part being securable to the spherically adjustable part (see fig 8 below), and sighting means including a probe (fig 8, #13) having a part engagable with the head and/or neck of the femur (fig 8, #15). The base part comprises a plurality of circular plates (fig 6, #1 and #2) having a central aperture (fig 5, #37). The apparatus comprises an enclosure having a cylindrical lower portion and a part-spherical upper portion (see figure 10 below) with a central opening (see figure 6 below). The lower portion is outwardly steeped to provide an annular so the plates can be located inside an open end of the lower portion (see fig 6 below). An adjustment member configured to be received within the enclosure has a cylindrical lower part (fig 6, #43) and a part-spherical upper portion that matches the upper portion of the enclosure (see figure 10 below) having a hollow cylindrical boss through the central opening of the enclosure (fig 6, #6). The apparatus further

comprises a circular lock ring removable attached to the exterior of the enclosure (fig 6, #5). A cannula guide having an external flange adjacent to a reduced diameter of the body is configured to be received by the boss when the boss extends through a hole in the lock ring (see fig 8 below). A sighting disc extends closely through a central circular aperture of a body of the cannula guide (see figure 8 below) and is on an end of a circular rod of the probe. The adjustment member is configured to receive magnetic material.

Marchione et al shows the method of using the apparatus comprising securing a base part to the head of the femur at approximately the axis; appropriately adjusting the attitude of a second part, the second part being securable to and spherically adjustable relative to the base part, prior to fitting thereto a third part; fitting the third part to the second part, wherein the third part is for directly or indirectly receiving a wire guide and arranged for plan or adjustment; setting a planar position of the third part and subsequently adjusting same if necessary in response to engagement of a portion of a probe with the head or neck of the femur and inserting the guide wire ("Kirschner nail") directly or indirectly into the third part upon any adjustment of the third part's planar position having been completed (paragraph 22).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2002/0193801 to Marchione et al in view of US Patent 5,616,147 to Gadelius.

Marchione et al discloses the claimed invention with projecting anchoring pins; Marchione et al does not disclose three equiangularly spaced apertures that are threaded and a plurality of headed studs with a pointed end.

Gadelius discloses three equiangularly spaced apertures that are threaded (fig 2 col. 2 ll. 10-15) and a plurality of headed studs with a pointed end (fig 1, #6) to fix the plates in bone (col. 2 ll. 10-13).

It would have been obvious at the time of the invention to one of ordinary skill in the art to substitute projecting anchoring pins of Marchione et al with the three equiangularly spaced apertures that are threaded and a plurality of headed studs with a pointed end in view of Gadelius because projecting anchoring pins and three equiangularly spaced apertures that are threaded and a plurality of headed studs with a pointed end are mere functional equivalents, and because such a substitution of one for the other would have achieved the same predictable result of fixing a plurality of plates into bone.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2002/0193801 to Marchione et al in view of US Patent 5,688,281 to Cripe et al

Marchione et al discloses the claimed invention except for equiangularly spaced slots extending partly through the part-spherical upper surface of the adjustment member.

Cripe et al discloses for equiangularly spaced slots (fig 4, #232) extending partly through the upper surface of the adjustment member (fig 4, #244) to properly align the tool with the mechanical axis (col. 3 ll. 29-33).

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the device of Marchione et al with equiangularly spaced slots extending partly through the part-spherical upper surface of the adjustment member in view of Cripe in order to properly align the tool with the mechanical axis.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2002/0193801 to Marchione et al.

Marchione discloses the claimed invention except for the base part being formed as a single piece. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the base part a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Conclusion

The prior art made of record on PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. COTRONEO whose telephone number is (571)270-7388. The examiner can normally be reached on M-F 730-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on 571-272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. C./
Examiner, Art Unit 4138

/Melba Bumgarner/
Supervisory Patent Examiner
Art Unit 4138